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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,585	01/19/2000	Scott Wayne Weller	104433	3330

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EXAMINER	
HILLERY, NATHAN	
ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/487,585	WELLER, SCOTT WAYNE	
	Examiner	Art Unit	
	Nathan Hillery	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,12-16,18-22 and 24-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10,12-16,18-22 and 24-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: RCE filed on 5/24/04.

2. Claims 1 – 10, 12 – 16, 18 – 22 and 24 – 37 are pending in the case. Claims 1, 15, 20 and 21 are independent.

3. The objection to the claims has been withdrawn as necessitated by amendment.

4. The rejection of claims 1 – 10, 12 – 16, 18 – 22 and 24 – 37 under 35 U.S.C. 103 (a) as being unpatentable has been withdrawn as necessitated by amendment.

Continued Examination Under 37 CFR 1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/23/04 has been entered.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one,or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 6, 16, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. **Regarding dependent claims 6, 16, and 22**, it is unclear what Applicant means by "non-selectable injectable content" and how such content can then be selected (line 12 of claim 1).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 2, 13, 14, 15, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Serra et al. (US 6674539 B1).

10. **Regarding independent claims 1, 15, and 21**, Serra et al. teach that *as can be seen from FIG. 2, the process starts at the step 40. At the step 41, the low resolution image generator or image server 12b receives an access request. The access request can be sent from the user terminal 13b of the user terminal system 13 or the print order generator 14b of the printing service provider system 14. The access request asks the image server 12b to retrieve the image data of the requested image from the corresponding image content site 12a. The access request also specifies the resolution of the image to be transferred* (Column 6, lines 23 – 32), which provide for **receiving information at a server** (*image provider system*), **wherein the received information identifies downloadable information** (*image*). Serra et al. teach that *the user at the*

user terminal 13b can then view and customize the image as he or she wishes. The customization of the displayed image includes typical image processing operations, such as cropping the image, rotating the image, adding overlay text to the image, placing the image on various location of a page, and scaling the image (Column 5, lines 3 – 9), which provide for **determining whether the received information contains a specified location; inserting, if the received information contains the specified location, the injectable content into the received information at the specified location, wherein inserting the injectable content includes associating the injectable content with the downloadable information accessible by the server.** Serra et al. teach that *a method for printing an image in a distributed network system is described. The distributed network system includes an image provider system, a printing service provider system, and a user terminal coupled together via a network. First, a low resolution version of the image is received in the user terminal from the image provider system for viewing. The user can then customize the low resolution image by performing typical image processing operations (cropping, adding text, re-scaling, etc). The low resolution version of the image, once customized, is sent to the printing service provider system. Then the printing service provider system receives a high resolution version of the image from the image provider system such that the high resolution version instead of the low resolution version of the image is printed by the printing service provider system. Once the high resolution version of the image is received in the printing service provider system, the printing service provider system applies the customization to the high resolution image before printing the high resolution*

image (Column 1, line 64 – Column 2, line 15), which provide for **outputting the received information including the injectable content to the accessing device** (*user terminal*); **selecting the injectable content displayed by the accessing device; and outputting to an output device** (*printing service provider system*) **the downloadable information identified by the injectable content without routing, data contained in the downloadable information through the accessing device**. In addition, Serra et al. teach that *the image provider system 12 includes an image content site (i.e., the image content site 12a) that stores images. A content site refers to a collection of data (e.g., a database or file system) that contain a set of content data and/or applications for access* (Column 3, lines 25 – 30), which provide for **a content database that stores injectable content**. Further, it is inherent that the invention of Serra et al. must be run on a computer with memory; therefore, it has **a memory that stores a location ...**

11. **Regarding dependent claim 2**, Serra et al. teach that *in another embodiment, the image content site 12a stores image data as well as HTML (Hyper Text Markup Language) web pages, database objects, video clips, etc.* (Column 3, lines 30 – 34), which provides for **receiving information in the form of a document**.

12. **Regarding dependent claims 13 and 14**, Serra et al. teach that a*nother feature of the present invention is to allow a user to receive, view, and customize a low resolution version of an image while printing the high resolution version of the image via a remote printer through a distributed network system* (Column 1, lines 59 – 64), which

provide for **receiving and forwarding information using at least one of a wired connection or a wireless to a network**.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 6 – 10, 16 – 19, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serra et al. (US 6674539 B1) as applied to claims 1, 2, 13, 14, 15, and 21 above, and further in view of Fields et al. (US 6605120 B1).

15. **Regarding dependent claims 6 – 8, 16, 18, and 22, 24,** Serra et al. do not explicitly teach **nonselectable or selectable content**. Fields et al. teach that *variations in which elements are preserved in the recast page are possible ... the logo (Figure 4A.305) is an optional feature ... it may be removed or reduced in size or replaced by a different logo ... the links (Figure 4A.311) are optional; they could be removed, reformatted or relocated ... the ad banner (Figure 4B.313) is optional* (Column 7, lines 16 – 27), which means **the injectable content includes nonselectable injectable content** (logo), **injectable content includes selectable injectable content** (links, ad banner), **and content includes a link to another document source ...** (links, ad banner). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Serra et al. with that of Fields et al. because such

a combination would allow the users of Serra et al. the benefit of *enabling a publisher of an electronic document to control the reformatting of the document by a hosting site* (Column 2, lines 63 – 65).

16. **Regarding dependent claim 9 and 19**, Serra et al. do not explicitly teach **selectable content**. Fields et al. teach that *it is an object of the invention to reuse web-based content without requiring a content provider web site to install special purpose software* (Column 2, lines 59 – 63), which means **the selectable injectable content provides processing without installing software on the accessing device**. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Serra et al. with that of Fields et al. because such a combination would allow the users of Serra et al. the benefit of *enabling a publisher of an electronic document to control the reformatting of the document by a hosting site* (Column 2, lines 63 – 65).

17. **Regarding dependent claim 10**, Serra et al. do not explicitly teach **selectable content**. Fields et al. teach that *the tool constructs the filter so that when the filter is used, the selected content elements are extracted from a received web page from the content provider web server and reused in the recast web page ... as part of the process of identifying the selectable content elements, a set of varied headers can be used to retrieve multiple versions of the same web page ... the multiple versions of the web page are compared to identify static and dynamic content elements and marked as such* (Column 3, lines 12 – 20), which means **processing of the selectable injectable content is provided within a server**. It would have been obvious to one of ordinary

skill in the art at the time of the invention to combine the invention of Serra et al. with that of Fields et al. because such a combination would allow the users of Serra et al. the benefit of *enabling a publisher of an electronic document to control the reformatting of the document by a hosting site* (Column 2, lines 63 – 65).

18. Claims 3 – 5, 12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serra et al. (US 6674539 B1) as applied to claims 1, 2, 13, 14, 15, and 21 above, and further in view of Yang et al. (US006301586B1).

19. **Regarding dependent claims 3 – 5 and 12**, Serra does not explicitly teach **the specified location ...** However, Yang et al. discloses in Figure 14 that **the specified location is top, bottom, left margin, or right margin of document** (*Picture Layout – horizontal, vertical*), **the specified location is adjacent to any downloadable information identified in the received information** (*Picture Layout – Diagonal*), **the downloadable information identified in the received information is at least a file, a folder, a picture, a movie, a sound, or a document** (*Picture Layout – Diagonal [to another picture]*), and **the specified location to insert the injectable content is determined by a user** (*selecting the print layout*). It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the invention of Serra et al. with that of Yang et al. because such a combination would provide the users of Serra et al. with *an improved management of multimedia objects by means of enhanced input, manipulation, and output* (Yang et al., Column 1, lines 44 – 47).

20. **Regarding independent claim 20**, the claim incorporates substantially similar subject matter as claims 1, 7, and 8, and is rejected along the same rationale. Further, Serra et al. does not explicitly teach **a graphical user interface ...** However, Yang et al. discloses in Figure 15 **a graphical user interface** ... It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the invention of Serra et al. with that of Yang et al. because such a combination would provide the users of Serra et al. with *an improved management of multimedia objects by means of enhanced input, manipulation, and output* (Column 1, lines 44 – 47).

21. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Serra et al. (US 6674539 B1) as applied to claims 1, 2, 13, 14, 15, and 21 above, and further in view of Wolff (US 6738841 B1).

22. **Regarding dependent claim 25**, Serra et al. do not explicitly teach **option screen**. However, Wolff teaches that *FIG. 3a illustrates one embodiment of a document 300 printed at printer 250. Printer driver 255 also attaches control buttons to the retrieved document and transmits the print view version of the document to the user at client 210. FIG. 3b illustrates one embodiment of a print view page 350 of a document displayed on a browser 320 residing in client 210. View page 350 includes control buttons 360 labeled "PRINT", "OPTIONS", and "STATUS". The "PRINT" button contains a tag that causes printer server 255 to transmit the document for download to the digital hardware and print engine components of printer 250. The "OPTIONS" and "STATUS" buttons cause printer server 255 to serve up an option selection form and a*

printer status page, respectively (Column 6, lines 7 – 20), which provide that **at least one injectable content includes at least one selectable icon to access at least one treatment option screen**. It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the inventions of Serra et al. with that of Wolff because such a combination would provide the users of Serra et al. with *a method and apparatus for creating electronic documents and controlling printer peripherals* (Column 3, lines 49 – 50).

23. Claims 26 – 29, and 31 – 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serra et al. (US 6674539 B1) and Wolff (US 6738841 B1) as applied to claim 25 above, and further in view of Yang et al. (US006301586B1).

24. **Regarding dependent claim 26 – 29, 35, 36, and 37**, neither Serra et al. nor Wolff explicitly teach **a treatment option screen**. However, Yang et al. discloses in Figure 13 that **the treatment option screen has an option to process downloadable information, the treatment option screen is separately displayed for each downloadable information, each treatment option screen is sequentially displayed for each downloadable information, each treatment option screen includes a selectable icon to return to a previous treatment option window** (*Back*), **the treatment option screen includes a selectable icon to accept the treatment** (*Finish*), **the treatment option screen includes a selectable icon to exit** (*Cancel*), and **the treatment option screen comprises at least one portion** ... (*Horizontal, Vertical, Diagonal*). It would have been obvious to one with ordinary skill in the art at the

time of the invention to combine the invention of Serra et al. and Wolff with that of Yang et al. because such a combination would provide the users of Serra et al. and Wolff with *an improved management of multimedia objects by means of enhanced input, manipulation, and output* (Column 1, lines 44 – 47).

25. **Regarding dependent claim 31 – 34**, neither Serra et al. nor Wolff explicitly teach **a treatment option screen**. However, Yang et al. discloses in Figures 13 – 16 that **the treatment option screen lists each downloadable information** (*Left Box*), **the list includes at least one markable box** (*Right Box*), **and each marked box indicates that the associated downloadable information is to be processed**. It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the invention of Serra et al. and Wolff with that of Yang et al. because such a combination would provide the users of Serra et al. and Wolff with *an improved management of multimedia objects by means of enhanced input, manipulation, and output* (Yang et al., Column 1, lines 44 – 47). Further, it would have been obvious to one with ordinary skill in the art at the time of the invention to know that since the combined invention already performs the demarcation of boxes in one manner then it would be trivial to make so that each marked box indicates that the associated downloadable information is not to be processed.

26. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Serra et al. (US 6674539 B1), Wolff (US 6738841 B1) and Yang et al. (US006301586B1) as

applied to claims 26 – 29, and 31 – 37 above, and further in view of Roosen et al. (US006618163B1).

27. **Regarding dependent claim 30**, Serra et al., Wolff and Yang et al. do not explicitly teach **the treatment option screen** ... However, Roosen et al. discloses in Figure 8 that **the treatment option screen has at least one first portion, at least one second portion, and at least one control for moving**... It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the inventions of Serra et al., Wolff and Yang et al. with that of Roosen et al. because such a combination would allow the users of the aforementioned inventions to have *access to an invention that meets the need for enhanced printer status information, monitoring and control* (Column 2, lines 10 – 11).

Response to Arguments

28. Applicant's arguments with respect to claims 1 – 10, 12 – 16, 18 – 22 and 24 – 37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (703) 305-4502. The examiner can normally be reached on M - F, 6:30 a.m. - 3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NH

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER